

REMARKS

Claims 1–20 are pending in the application with claims 1, 11, and 18 being the independent claims. Claim 1 is amended. No claims are newly added or canceled without prejudice to or disclaimer of the subject matter therein. Support for these claim amendments can be found in the specification, claims, and drawings as originally filed. Reconsideration of presently pending claims 1–20 is respectfully requested in light of the above amendments and the following remarks.

Allowed Subject Matter

Noted with appreciation is the indication in the Office Action that claims 11–20 are allowed. Final Office Action, Page 4.

Rejections Under 35 U.S.C. § 103

Claims 1–10 are rejected under 35 U.S.C. § 103 as being unpatentable over Slivka, et al. (U.S. Patent No. 5,455,577, hereinafter referred to as “Slivka”). Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claims 1–10.

In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that:

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. *Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

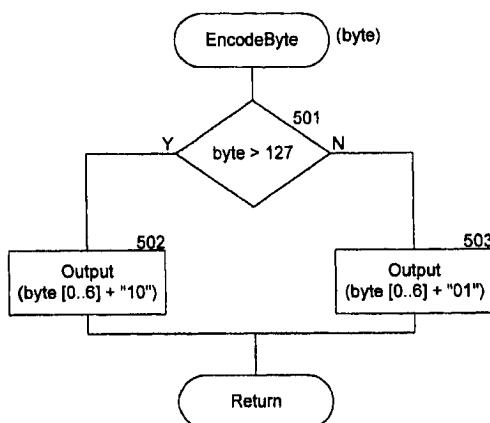
The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

It is submitted that, in the present case, a *prima facie* case of obviousness does not exist for the claims as herein amended for the following, mutually exclusive, reasons.

Independent Claim 1

MPEP § 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” (quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)). In the present matter, claim 1 has been amended. Specifically, amended independent claim 1 now requires “not inserting an identifier after each byte of the one or more bytes, if the first byte is smaller than the value.” (emphasis added).

The Office Action references FIG. 5 as teaching independent claim 1, which is reproduced below.



Slivka teaches that:

FIG. 5 is a flow diagram of the function EncodeByte. The function EncodeByte is passed a byte value to encode and outputs to the compressed stream the byte-value in accordance with MRCF encoding. In step 501, if the value of the passed byte is greater than 127, then the function continues at step 502, else the function continues at step 503. In step 502, the function outputs to the compressed stream the least significant seven bits of the passed byte plus a “10” to indicate a byte of greater than 127 and returns. In step 503, the function outputs to the compressed stream the least significant seven bits of the passed byte and a “01” to indicate a byte of 127 or less and returns.

Applicants respectfully contend that Slivka teaching “[i]n step 503, the function outputs to the compressed stream the least significant seven bits of the passed byte and a ‘01’ to indicate a byte of 127 or less” fails to teach ““not inserting an identifier after each byte of the one or more bytes, if the first byte is smaller than the value.” (emphasis added).

Thus, for this independent reason alone, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. § 103 should be withdrawn.

Dependent Claims 2-10

Claims 2-10 depend from, either directly or indirectly, and further limit independent claim 1. Accordingly, these claims are allowable for at least the same reasons set forth above in claim 1. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection and allow these claims.

Conclusion

For at least the reasons set forth above, Applicant submits that the pending claims 1-20 are in condition for allowance. Accordingly, Applicant respectfully requests that the Examiner withdraw the outstanding objections and rejections and issue a formal notice of allowance.

The Office Action contains characterizations of the claims and the related art to which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

Respectfully submitted,



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